

REMARKS

Reconsideration of the present application as amended is requested.

¶1 of page 3 of the specification has been amended to indicate the correct inventorship of U.S. Patent No. 5,375,768, as cited therein.

In order to expedite prosecution, all of the currently elected claims have been canceled except for Claim 1 which has been amended.

In the Office Action mailed May 20, 2005, Claim 1 was rejected for lack of novelty over U.S. Patent No. 5,375,768 of Michael L. Clark. '768 of Clark, which is distinguished on page 3, lines 1-6 of the subject application, discloses a rotor-type sprinkler in which a valve diverts a portion of the water around the turbine in proportion to the pressure of the water for maintaining the speed of the turbines substantially constant. The valve does not detect air, or a mixture of water and air, if the fluid entering the sprinkler is not substantially entirely water.

The examiner bears the burden of establishing a *prima facie* case of anticipation. *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138-139 (Fed. Cir. 1986). Each claim in issue must first be correctly interpreted to define the scope and meaning of each limitation. *In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). The prior art reference must disclose each element of the claimed invention, as correctly interpreted, and as "arranged in the claim." *Lindermann Maschinefabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984).

On the law of anticipation, Judge Learned Hand stated:

"No doctrine of the patent law is better established than that a prior patent or other publication to be an anticipation must bear within its four corners adequate directions for the practice of the

patent invalidated. If the earlier disclosure offers no more than a starting point for further experiments, if its teaching will sometimes succeed and sometimes fail, if it does not inform the art without more how to practice the new invention, it has not correspondingly enriched the store of common knowledge, and it is not an anticipation.¹

Amended Claim 1 requires a valve that prevents over-spinning of the turbine when the pressurized fluid is air or a mixture of water and air. The valve of Clark does not meet this limitation. Accordingly, withdrawal of the rejection of Claim 1 for anticipation over Clark is requested.

Submitted herewith is a supplemental Information Disclosure Statement along with Sheet 3 of 3 of Form PTO-1449, along with a check for the required fee in connection with 37 CFR §1.17(p).

The present application is believed to be in condition for allowance, and notification to this effect is solicited. No fees other than those submitted herewith are believed to be due at this time. However, any additional fees required may be charged to Deposit Account No. 50-0626.

Respectfully submitted,



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¹Dewey & Almy Chem. Co. v. Mimex Co., 124 F.2d 986,989 (2d Cir. 1942).